

REMARKS

Claims 3-7, 9-11, 13 and 15 were examined and reported in the Office Action. 3-7, 9-11, 13 and 15 are rejected. Claims 4 and 15 are canceled. Claim 3, 5-7, 9-11, 13 and 15 is amended. New claims 16-17 are added. Claims 3, 5-7, 9-11, 13 and 15 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. In the Drawings

It is asserted in the Office Action that the drawings are objected to under 37 CFR §1.83(a) for not showing every element claimed. Applicant has amended the Fig. to include the disclosed and claimed limitations. Approval is respectfully requested.

II. 35 U.S.C. § 112, first paragraph

It is asserted in the Office Action that claims 3-7, 9-11, 13 and 15 are rejected under 35 U.S.C. § 112 first paragraph, as failing to comply with the enablement requirement. Applicant respectfully traverses the aforementioned rejections for the following reasons.

It is asserted in the Office Action that the specification does not describe or identify the “means adapted to provide the position of the valve or the calibration surface means.” Applicant has canceled claim 4, which had previously contained “calibration surface means” limitations.

Applicant submits that an ordinary person skilled in the art would understand how this could be achieved. Such devices are well known in the art, for example rheostats, ultrasonic devices, inductive or capacitive inducers, laser based systems, etc. The skilled addressee would not require any inventive effort in order to make use of a valve position measurement device, which would be within his skill. The invention lies in converting a valve to become a flow measuring device for fluid, part of which is providing means adapted to provide a current position of the valve.

Accordingly, withdrawal of the 35 U.S.C. § 112 first paragraph rejections for claims 3, 5-7, 9-11, 13 and 15, are respectfully requested.

III. 35 U.S.C. § 112, second paragraph

It is asserted in the Office Action that claim 4 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant has canceled claim 4. Therefore, the 35 U.S.C. § 112, second paragraph rejection is moot.

IV. 35 U.S.C. § 102

It is asserted in the Office Action that claims 3-7, 9-11, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiffert (DE4025323). Applicant respectfully traverses the aforementioned rejections for the following reasons.

According to MPEP §2131,

'[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant's amended claim 3 contains the limitations of

[a]n apparatus for converting a valve means for use as a flow meter for fluid, comprising: (i) a valve housing; (ii) a movable valve of said valve housing; means for measuring differential pressure across the valve housing; means adapted to provide current position of said valve; and means adapted to calculate flow rate from said measured differential pressure and said current valve position.

It is asserted in the Office Action that Seiffert teaches a flow metering device.

Applicant's claimed invention discloses an apparatus for *converting a valve means for use as a flow meter* for fluid. Seiffert does not, and cannot, teach, disclose or suggest that conversion of a valve to be used as a flow meter, as Seiffert provides a ready made flow metering device.

A skilled person in the art wishing to convert an existing valve to perform as a flow meter for fluid could not use the teaching of Seiffert to do this as the measuring device is integral with the valve. Seiffert does not address the problem of retrofitting valves. Therefore, Seiffert cannot teach how to overcome that problem. Further, as can be seen from the figures of Seiffert, the valve requires preformed, integrated channels or bores in order to measure the pressure differential. The channels could not be retrofitted in the form presented in Seiffert.

Further, according the MPEP 2111.03

[A] claim preamble has the import that the claim as a whole suggests for it." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

Applicant asserts that preamble of *an apparatus for converting a valve means for use as a flow meter for fluid* is "necessary to give life, meaning and vitality" to the claim.

Therefore, since Seiffert does not disclose, teach or suggest all of Applicant's amended claim 3 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Seiffert. Thus, Applicant's amended claim 3 is not anticipated by Seiffert. Additionally, the claims that directly or indirectly depend on claim 3, namely claims 5-7, 9-11 and 13, are also not anticipated by Seiffert for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejections for claims 3, 5-7, 9-11 and 13 (claims 4 and 15 are canceled) are respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 3, 5-7, 9-11, 13 and 16-17 are in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on November 18, 2005, Applicant respectfully petitions Commissioner for a three (3) month extension of time, extending the period for response to May 18, 2006. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$1,020.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(3) large entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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By: _____

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Dated: May 16, 2006

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on May 16, 2006.

Jean Svoboda